



1632

DEC 26 2002

Please write plus sign (+) inside this box → +

PTO/SB/21 (08-00)

Approved for use through 10/31/02 OMB 0651-0031

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number Of Pages In This Submission

Application Number

09/427,699

Filing Date

27 October 1999

RECEIVED

First Named Inventor

Ming ZHAO

DEC 30 2002

Group Art Unit

1632

Examiner Name

S. L. Chen, Ph.D.

TECH CENTER 1600/2900

Attorney Docket No.

312762001800

ENCLOSURES (check all that apply)

- | | | |
|---|---|---|
| <input type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Assignment Papers
(for an Application) | <input type="checkbox"/> After Allowance Communication to Group |
| <input type="checkbox"/> Fee Attached | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
| <input checked="" type="checkbox"/> Amendment / Reply | <input type="checkbox"/> Licensing-related Papers | <input type="checkbox"/> Appeal Communication to Group
(Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final | <input type="checkbox"/> Petition | <input type="checkbox"/> Proprietary Information |
| <input type="checkbox"/> Affidavits/declarations | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Status Letter |
| <input type="checkbox"/> Extension of Time Request | <input type="checkbox"/> Change of Correspondence Address | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below) |
| <input type="checkbox"/> Express Abandonment Request | <input type="checkbox"/> Terminal Disclaimer | <input checked="" type="checkbox"/> Return Postcard |
| <input type="checkbox"/> Information Disclosure Statement | <input type="checkbox"/> Request for Refund | <input type="checkbox"/> |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | <input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> |
| <input type="checkbox"/> Response to Missing Parts/
Incomplete Application | Remarks | |
| <input type="checkbox"/> Response to Missing Parts
under 37 CFR 1.52 or 1.53 | | |

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm or Individual Name	Kate H. Murashige, Reg No. 29,959 Morrison & Foerster LLP 3811 Valley Centre Drive, Suite 500, San Diego, California 92130
Signature	
Date	December 18, 2002

CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on December 18, 2002.

Tami M. Procopio

Burden Hours Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO Assistant Commissioner for Patents, Washington, DC 20231.



PATENT
Docket No. 312762001800

CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box AF, Assistant Commissioner for Patents, Washington D.C. 20231, on December 18, 2002.

Tami M. Procopio

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Ming ZHAO *et al.*

Serial No.: 09/427,699

Filing Date: 27 October 1999

For: TREATMENT OF ALOPECIA

Examiner: Shin-Lin Chen, Ph.D.

Group Art Unit: 1632

RECEIVED
DEC 30 2002
TECH CENTER 1600/2900

AMENDMENT UNDER 37 C.F.R. §1.111

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is in response to an Office action herein mailed 18 September 2002 time for response which was set to expire 18 December 2002. The pending claims, claims 1-5 and were rejected under 35 U.S.C. § 102(e)(f) and/or (g) as anticipated by Lishko *et al.*, U.S. Patent No. 5,753,263. Reconsideration of this basis for rejection is respectfully requested.

As the Office correctly points out, the Lishko patent indeed discloses a method of preventing chemotherapy -induced alopecia by delivering an expression vector comprising a nucleic acid molecule coding for p21 entrapped in a liposomal composition. The inventorship set forth on this patent is Lishko and Lingna Li. The Office also correctly points out that one way to overcome the rejection under 35 U.S.C. § 102(e) is to show that the invention disclosed but not claimed in the '263 patent was derived from the inventor of the present application. Applicant believes that this

has already been done. Applicant's have already pointed out, for example, in their submission dated 6 March 2002 that the contribution of Valeryi Lishko, the listed inventor other than Lingna Li in the '263 did not involve p21. Therefore, that invention is solely the invention of Lingna Li, who is the sole inventor in the present application as further discussed below. There is nothing in the outstanding rejection under 35 U.S.C. § 102(e) that provides any basis for doubting this statement or questions the adequacy of that representation. As the present applicant has supplied sufficient reason to show that the invention disclosed but not claimed in the '263 patent was derived from the inventor herein, it appears this basis for rejection is overcome.

With respect to the rejection under 35 U.S.C. § 102(f) or (g) the Office questions whether Zhao and Saito can be removed as inventors under 37 C.F.R. § 1.48(b) because the declaration filed 2/1/00 indicated that they contributed to the inventions claimed. The Office is reminded that their petition under 37 C.F.R. § 1.48(a) to add Linga Li as an inventor was granted; the declaration filed along with that petition which supercedes the original declaration indicated that all of Li, Zhao and Saito contributed to the claims then pending. The claims then pending included claims 8-12 having to do with observing the expiration of p21 in hair follicle cells; it is to that claim that their contributions were made. As claims 8-12 to that aspect of the invention were cancelled, the invention to which Zhao and Saito contributed is no longer being claimed. Accordingly, it is appropriate to delete them as inventors under 37 C.F.R. § 1.48(b). The declaration accompanying the petition to add inventor Li confirms that Li, along with Saito and Zhao contributed to the invention then claimed. The declaration is not specific to claim 1.

Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

As it has been shown that Lingna Li is the sole inventor of the invention as now claimed as well as the disclosed but unclaimed invention in the '263 patent, it is believed that the rejections may be withdrawn and claims 1-5 and 7 passed to issue.

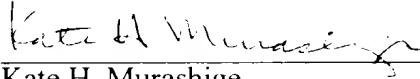
In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the

cost of such petitions and/or other fees due in connection with the filing of this document to
Deposit Account No. 03-1952 referencing docket no. 312762001800. However, the Assistant
Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: December 18, 2002

By:


Kate H. Murashige
Registration No. 29,959

Morrison & Foerster LLP
3811 Valley Centre Drive,
Suite 500
San Diego, California 92130-2332
Telephone: (858) 720-5112
Facsimile: (858) 720-5125